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Response Under 37 C.F.R. § 1.116 -
Expedited Procedure - Examining Group

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#16 8/16/00

In re application of:

NAGY ET AL.

Group Art Unit: 1713

Examiner: Roberto Rabago

Serial No.: 08/872,659

Filed: June 10, 1997

For: TRANSITION METAL CATALYSTS CONTAINING BIDENTATE LIGANDS AND METHOD OF USING AND PREPARING SAME

Attorney Docket No.: 016199/1110

AMENDMENT UNDER 37 C.F.R. § 1.116 AND PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136(a)

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Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231

Sir:

Applicant hereby petitions for a one month extension of time to respond to the Office Action dated April 6, 2000, thereby extending the time period within which to respond to August 6, 2000.

Responsive to the final Office Action dated April 6, 2000, kindly reconsider the

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this paper, including all enclosures referred to herein, is being deposited with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to: Commissioner for Patents, United States Patent and Trademark Office, Washington, D.C. 20231 on:

August 7, 2000	William G. Conger	
Date of Deposit	Name of Person Signing	Signature

claims in view of the following remarks. Claims 22-35, 37-51, and 53-73 are pending. Claims 71, 72, and 73 are the broad claims, all requiring a catalyst (or use thereof) of the scope of claim 71.

The sole remaining rejection is under 35 U.S.C. § 103(a) over Reichle et al. U.S. Patent 5,852,146 (hereinafter, *Reichle*). *Reichle* issued on December 22, 1998, while the subject application was filed on June 9, 1997, claiming priority as a CIP to U.S. Serial No. 08/423,232 filed April 17, 1995, now U.S. Patent 5,637,660. *Reichle* is therefore only a reference under 35 U.S.C. § 103(a) through 35 U.S.C. § 102(e), and since there is no dispute that the claimed subject matter of *Reichle* and the present invention do not overlap, Applicants are entitled, under 37 C.F.R. § 1.131, to swear behind *Reichle*, thus removing *Reichle* as a reference.

Applicants believe that the prior Office Actions and Responses have created some uncertainty as to what the real issues as to patentability are. Hopefully, the following will both clarify this matter as well as persuade the Office that the claims are indeed patentable.

The *Reichle* reference was filed prior to the present application's filing date, but did not issue until later. *Reichle* is not a § 102(b) reference, and therefore the present claims are patentable if the applicant either 1) is entitled to the *Nagy* parent application's filing date of April 17, 1995, more than one year prior to the *Reichle* filing date; or 2) provides evidence of a conception and reduction to practice (37 C.F.R. § 1.131) earlier than *Reichle's* filing date.

Whether Applicants are entitled to the *Nagy* parent application's filing date is subject to dispute, based on the presently existing case law. Applicants believe they are so entitled, and will explain this belief below. However, Applicants do not rely on this

entitlement, but rely on their conception and reduction to practice which predated *Reichle's* filing date.

In re Ziegler, 146 U.S.P.Q. 76 (CCPA 1965) indicates that entitlement to a parent application's priority date under 35 U.S.C. §§ 119 or 120 so as to defeat a rejection over an intervening reference is satisfied in a situation where later filed genus claims require support of parent application species claims, if the parent's species would be sufficient to antedate the intervening reference under either § 102 or § 103. The clear language of *Ziegler* has been muddied by subsequent cases: *Kawai v. Metlesics*, 178 U.S.P.Q. 158 (CCPA 1973); *In re Gosteli*, 10 U.S.P.Q.2d 1614 (Fed. Cir. 1989); *Ex parte Kitamura*, 9 U.S.P.Q.2d 1787 (B.P.A.I., 1988). Here, the Examples and claims of the *Nagy* parent application, which constitute at least a constructive reduction to practice, are clearly sufficient to antedate *Reichle*.[1] Under the holding of *Ziegler*, Applicants are entitled to rely on the *Nagy* parent filing date of April 17, 1995, and thus *Reichle* is not a proper reference.[2]

However, regardless of whether *Reichle* is a reference or not, the *Nagy* parent application's specification and claims, together with the Declaration filed therewith, provide the necessary evidence under 37 C.F.R. § 1.131 to antedate *Reichle*. This evidence is of

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[1]*Reichle* originally claimed "interfering" subject matter, but amended the claims during prosecution, thus acknowledging both lack of priority over Applicants' *Nagy* parent application as well as obviousness of the original claims thereover.

[2]Applicants also wish to bring to the attention of the Office its position that the *Reichle* application is not entitled to its filing date as its effective date as a reference. The fiction that an application could issue the same day as filed is not applicable here. *Nagy* could not have issued the same day as filed, since there was overlapping subject matter with the *Nagy* parent application, which was pending. Following allowance and issue of *Nagy*, either an interference would have been required which would have required the statutory period of notice to *Nagy*, the senior party, or the claims would have had to be amended, as they were. Since the *Nagy* application did not issue until June 10, 1997, and the *Nagy* CIP was filed June 9, 1997, *Reichle* could not be issued as amended until June 10 at the earliest. Thus, for this reason, *Reichle* is not prior art.

record in the U.S. Patent and Trademark Office. In other words, even if the claims are entitled (*arguendo*) only to the filing date of the *Nagy* CIP, the *Nagy* parent application is evidence under Rule 1.131 of conception and reduction to practice earlier than the *Reichle* filing date. That a prior filed application to which priority is claimed can be accepted as a Rule 1.131 Declaration is set forth in *In re Mulder*, 219 U.S.P.Q. 189 (Fed. Cir. 1983):

> If entitlement to a foreign filing date can completely overcome a reference we see no reason why it cannot partially overcome a reference by providing the constructive reduction to practice element of proof required by Rule 1.131. (Emphasis added).

Mulder at 193.

The parent application, with respect to the catalysts disclosed therein, is of substantially the same or greater scope than *Reichle*. For example, the Y linking group of the parent application can be O, S, or NR, while *Reichle* discloses only O. Similarly, the parent application discloses a number of ring substituents R' including alkyl, alkoxy, aryl, halogen, or CF_3, while *Reichle* discloses only $C_{1\text{-}20}$ hydrocarbons. The "L" and "X" groups of the parent application include halogen, alkyl, alkoxy, $-NR_2$, cyclopentadienyl, alkyl-substituted cyclopentadienyl, indenyl, fluorenyl, pyridyloxy or quinolyloxy or their S or NR analogues. *Reichle* discloses a highly overlapping group of hydrogen, halogen, alkyl, alkoxy, alkenyl, aryl, aralkyl and alkaryl, hydrocarbonoxy, $-NR_2$, and carboxy.

It is well established that an affidavit under Rule 1.131 need not show a conception and reduction to practice of every species of the reference. The antedating evidence need only render the reference teachings obvious:

> Certainly appellants should not be required to submit facts under Rule 131 showing that they reduced to practice that which is obvious in addition to those facts offered as showing a completion of the invention, for the purposes of antedating a reference.

In re Hostettler, 148 U.S.P.Q. 514 (CCPA 1966). Accord, *In re Clarke*, 148 U.S.P.Q. 670 (CCPA 1966). Both these cases are more fully set forth in Applicants' prior response. Note *Clarke*, in particular:

> We believe the rule in *Stempel* supplements our decision in *In re Shokal, supra*, and that the rule for antedating references is not limited to fact situations where the inventor can show priority as to the *identical* compound described in the reference. It seems that in an appropriate case an applicant should not be prevented from obtaining a patent to an invention where a compound described in a reference would have been obvious to one of ordinary skill in the art in view of what the affiant proves was completed with respect to the invention prior to the effective date of the reference. This is particularly true where the inventor had already appreciated that the invention was generic in nature from the work on diverse species and was endeavoring to determine by exercise of reasonable diligence the precise scope of the invention.[3]

Here, the Office has alleged that the present claims, which differ only in relatively minor respects from those of the *Nagy* parent application, are obvious over *Reichle*. If this is *prima facie* correct, then the *Nagy* parent application is sufficient evidence under Rule 131 to antedate *Reichle* under the reasoning of *Hostettler*, *Clarke*, and similar cases. This antedating of *Reichle* by the *Nagy* parent application as evidence under 37 C.F.R. § 1.131 is not dependent in any way, on the actual priority date accorded the instant claims. Even if the claims are entitled only to the CIP application's filing date, the antedating of *Reichle* is still effective to remove *Reichle* as a reference. Withdrawal of the rejection of the claims over *Reichle* is solicited.

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[3]Exactly the case here.

Applicants submit that the claims are now in condition for Allowance, and respectfully request a Notice to that effect. If the Examiner believes that further discussion will advance the prosecution of the Application, he is highly encouraged to telephone Applicants' attorney at the number given below.

A check in the amount of $110.00 is enclosed to cover the Petition fee. Please charge any additional fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978 -- a duplicate of this paper is enclosed for that purpose.

Respectfully submitted,

NAGY ET AL.

By _____

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Date: August 7, 2000

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